

REMARKS

Claims 1-15, 18 and 19 are pending in the present application.

In the outstanding final Office action dated January 25, 2006, claims 1, 4-6, 9, 12, 13, 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams et al. (5,341,818) in view of Gambale et al. (5,031,636). Additionally, claims 2, 3, 7, 8, 10, 11, 14 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams et al./Gambale et al. It is respectfully submitted, however, that the pending claims are patentable over the cited art.

Significantly, MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" and that "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill in the art at the time the invention was made' because references relied upon teach all of the aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." Further, the MPEP states that "The level of skill in the art cannot be relied upon to provide the suggestion to combine the references."

In the present situation, it is respectfully submitted that there is no motivation to combine the teachings of Abrams et al. and Gambale et al. since there is no recognition of any reason to modify the approach disclosed in Abrams et al. for attaching a proximal section of the core wire to a distal section of the core wire for a composite guide wire. In fact, Abrams et al. teaches that employing a hypotube structure about proximal and distal core wires is a satisfactory assembly approach, whereas the present invention is directed towards male and female components formed in the core wires themselves.

Moreover, it is believed to be highly significant that in rejecting claims 1, 4-6, 9, 12, 13, 18 and 19 under § 103(a), the Examiner merely stated that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the male end (15) of Abrams et al. as the teaching of Gambale et al. (reduced diametered tip 28 and also utilize the final end of Gambale et al. to form a guide wire extended)," without providing an objective reason to combine the teachings of the references. Therefore, it is respectfully submitted that the Examiner has not presented a *prima facie* case of obviousness because there is both a lack of motivation to modify Abrams et al. in view of Gambale et al. as well as no objective reason presented by the Examiner for making such a combination as is required under MPEP 2143.01. Thus, it is respectfully submitted that each of independent claims 1, 9, 18 and 19 as well as their respective dependent claims are allowable over the cited art for this reason alone.


Furthermore, even if one of ordinary skill in the art was somehow motivated to look beyond the teachings of Abrams et al. to modify the connection between proximal and distal sections of core wires for a composite guide wire, it is respectfully submitted that the ordinary artisan would not employ the Gambale et al. teachings concerning a guide wire extension 24 to modify the manner disclosed in Abrams et al. to affix proximal and distal sections of core wires to one another. That is, it is respectfully submitted that it is not obvious to use disclosure relating to extending a guide wire as taught by Gambale et al. to modify the teachings of Abrams et al. This is especially true here where each of the pending claims require "permanently" securing a male end within a female end and the Gambale et al. reference (See Col. 7, ln. 23 et seq.) states that "The connection may be broken easily and quickly should it be desired to separate the guide wire extension 24 from the guide wire 12." Accordingly, even if Abrams et al. was modified in view of the teachings of Gambale et al., such modification would still not meet the "permanently" secured/securing limitation recited in each of the pending claims.

Finally, in view of the foregoing barriers to modifying Abrams et al. in view of Gambale et al. as suggested by the Examiner, it is respectfully submitted that it is difficult to rationalize further modifying Abrams et al. beyond the teachings of Abrams et al. and Gambale et al. to arrive at the subject matter recited in independent claims 18 and 19 which require the proximal core portion to include the female end since it is the guide wire of Gambale et al., and not the "proximally positioned" extension 24 which includes a socket ("female end") 34. Therefore, it is respectfully submitted that independent claims 18 and 19 are allowable for these reasons as well.

CONCLUSION

Applicants have attempted to completely respond to the rejections set forth in the outstanding Office action. In view of the above amendments and remarks, Applicant respectfully request that the application be reconsidered, the claims allowed and the application passed to issue.

Respectfully submitted,
FULWIDER PATTON LLP

By: 
John V. Hanley
Registration No. 38,171

JVH:kst
Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201
120552.1